

**SERIAL NO. 09/764,220****DOCKET NO. 1293.1161**

very least, the failure to address the applicant's traversals would render the Examiner's decision to again reject the claims arbitrary and capricious and invalid under the Administrative Procedures Act, 5 U.S.C. § 706, the standard under which such rejections are reviewed in view of Dickinson v. Zurko, 527 U.S. 150, 50 USPQ2d 1930 (1999).

It is respectfully submitted that the Office Action does not address the Amendment filed January 7, 2004 in at least the below examples. Since the Office Action does not meet the above standard, it is respectfully requested that the Office Action be withdrawn and a new Office Action or Notice of Allowance be issued in compliance with MPEP 707.07(f).

By way of example, in the Office Action at pages 1-2, the Examiner rejects claims 1, 3-6, 8-10, 13-15, and 17-19 under 35 U.S.C. §102 in view of eSHOP Technology Merchant Manual. The Office Action appears to repeat the arguments presented in the Office Action of October 7, 2003 without addressing the Amendment of January 7, 2004, or the claims as presented therein. Further, the Office Action on page 12 does not include a response to the applicant's arguments and does not address the rejection of claims 1, 3-6, 8-10, 13-15, and 17-19 under 35 U.S.C. §102 in view of eSHOP Technology Merchant Manual. As such, it is respectfully submitted that at least this rejection does not comply with the requirements of MPEP 707.07(f), and it is requested that the rejection be withdrawn.

By way of an additional example, in the Office Action at pages 2-6, the Examiner rejects claims 1, 3-6, 8-10, 13-15, and 17-19 under 35 U.S.C. §102 in view of Blinn et al. (U.S. Patent No. 5,897,622). The Office Action appears to repeat the arguments presented in the Office Action of October 7, 2003 and the claim charts appearing in the analysis further do not set forth the claims as presented in the Amendment of January 7, 2004. Further, the Examiner's arguments on page 12 of the Office Action do not point to which feature of Blinn et al. corresponds to the recited invention, as presented, and instead merely repeats the rejection found on pages 2-6 without additional comment reflecting the claims as presented in the Amendment of January 7, 2004. As such, it is respectfully submitted that at least this rejection

**SERIAL NO. 09/764,220****DOCKET NO. 1293.1161**

does not comply with the requirements of MPEP 707.07(f), and it is requested that the rejection be withdrawn.

As a final example, on the Office Action at pages 6-10, the Examiner rejects claims 1, 3-6, 8-11, 13-16, 18 and 19 under 35 U.S.C. §103 in view of Kondoh et al. (U.S. Patent Publication No. 2001/56377) and Moore et al. (U.S. Patent No. 6,330,575). The Office Action appears to repeat the arguments presented in the Office Action of October 7, 2003. On page 12 of the Office Action, the Examiner acknowledges that the applicant has traversed the rejection, and does not does not assert that the combination of Kondoh et al. and Moore et al. discloses the features as recited in claim 1. Instead, the Examiner asserts that Blinn et al. addresses the Amendment. Since Blinn et al. is not used in the above noted rejection, it is unclear as to what combination is being asserted. Further, since the Examiner's comments do not address the asserted combination, which does not include Blinn et al., the Examiner has not rebutted or addressed the Amendment of January 7, 2004. As such, it is respectfully submitted that at least this rejection does not comply with the requirements of MPEP 707.07(f), and it is requested that the rejection be withdrawn.

In view of the above, it is respectfully requested that the Examiner withdraw the Office Action, and issue a new Office Action or a Notice of Allowance.

**REJECTION UNDER 35 U.S.C. §102:**

In the Office Action at pages 1-2, the Examiner rejects claims 1, 3-6, 8-10, 13-15, and 17-19 under 35 U.S.C. §102 in view of eSHOP Technology Merchant Manual. This rejection is respectfully traversed and reconsideration is requested.

By way of review, claim 1 recites, among other features, a shopping mall web server that "provides the agency product information ... to the customer web browser organized according to geographic information of the respective plurality of agencies." As noted by the applicant in the Amendment filed January 7, 2004, the eSHOP Technology Merchant Manual does not disclose or suggest organizing the store fronts of the eSHOP Technology Merchant Manual

**SERIAL NO. 09/764,220****DOCKET NO. 1293.1161**

according to geographical information. Further, a review of the rejection on pages 1-2 does not reveal that the Examiner asserts that such an organization exists, which is also consistent with the Examiner's statement on page 10 of the Office Action. Moreover, the Examiner's explanation of the continued rejection of claim 1 on page 12 of the Office Action does not contest or address this feature of the invention as recited in claim 1. As such, it is unclear from the record as to which portion of the eSHOP Technology Merchant Manual the Examiner asserts corresponds to the recited features including the above-noted feature of claim 1. Thus, it is respectfully submitted that the Examiner has not provided sufficient evidence that the eSHOP Technology Merchant Manual anticipates each claim feature as is requirement to maintain a prima facie anticipation rejection of claim 1 under 35 U.S.C. §102.

Further, consistent with the reasons set forth in the Amendment of January 7, 2004, which remain uncontested, as well in view of the Examiner's acknowledgements on page 10 of the Office Action, it is respectfully submitted that the eSHOP Technology Merchant Manual does not disclose the features of the invention recited in claim 1.

For at least similar reasons, it is respectfully submitted that the eSHOP Technology Merchant Manual does not disclose or suggest the invention recited in claims 3, 8, 13, 15, and 19.

Claims 4-6, 9, 10, 14, 17, and 18 are deemed patentable due at least to their depending from corresponding claims 3, 8, 13, and 15.

In the Office Action at pages 2-6, the Examiner rejects claims 1, 3-6, 8-10, 13-15, and 17-19 under 35 U.S.C. §102 in view of Blinn et al. (U.S. Patent No. 5,897,622). This rejection is respectfully traversed and reconsideration is requested.

As a point of clarification, it appears from the Examiner's citation of FIGs. on pages 2-6 and 12 that the Examiner is comparing the claims against related patent, Blinn et al. (U.S. Patent No. 5,999,914), since Blinn et al. (U.S. Patent No. 5,897,622) does not include a FIG.1A or a FIG. 1B. Therefore, both versions of Blinn et al. will be addressed individually.

**SERIAL NO. 09/764,220****DOCKET NO. 1293.1161**

The Examiner states on page 12 of the Office Action that FIG. 1A of Blinn et al. discloses a merchant store server 30 of FIG. 1A for each of a plurality of agencies, provides the agency product information, and receives the order information from the customer web browser through the internet at order processing module 130 of FIG. 1B. However, the Examiner does not assert on pages 2-6 or on page 12 of the Office Action which portion of the merchant store server 30 "provides the agency product information ... to the customer web browser organized according to geographic information of the respective plurality of agencies " as does the shopping mall web server recited in claim 1. As such, it is respectfully submitted that the Examiner has not provided sufficient evidence that Blinn et al. anticipates each claim feature as is required to maintain a prima facie anticipation rejection of claim 1 under 35 U.S.C. §102.

Further, a review of Blinn et al. (U.S. Patent No. 5,897,622), such as at FIG. 6, does not reveal that geographic information of a particular merchant is stored in the database 121 so as to be displayed or affect the organization of a display of the page generated by the dynamic page generator 125 and displayed on a customer browser 122. (Col. 6, lines 26-65; FIG. 2). As such, consistent with the Examiner's statement on page 10 of the Office Action, it is respectfully submitted that Blinn et al. (U.S. Patent No. 5,897,622) does not disclose, among other features, a shopping mall web server that "provides the agency product information ... to the customer web browser organized according to geographic information of the respective plurality of agencies" as recited in claim 1.

Moreover, a review of the Blinn et al. (U.S. Patent No. 5,999,914) does not reveal that the address or geographical information of the merchant is used in order to display or organize product information on a page generated by the dynamic page generator 110, but instead discloses displaying registration information, product offerings, promotional advertisements, and order forms. (Col. 9, lines 45-53). As such, consistent with the Examiner's statement on page 10 of the Office Action, it is respectfully submitted that, Blinn et al. (U.S. Patent No. 5,999,914) also does not disclose, among other features, a shopping mall web server that "provides the

**SERIAL NO. 09/764,220****DOCKET NO. 1293.1161**

agency product information ... to the customer web browser organized according to geographic information of the respective plurality of agencies" as recited in claim 1.

For at least similar reasons, it is respectfully submitted that Blinn et al. does not disclose or suggest the invention recited in claims 3, 8, 13, 15, and 19.

Claims 4-6, 9, 10, 14, 17, and 18 are deemed patentable due at least to their depending from corresponding claims 3, 8, 13, and 15.

**REJECTION UNDER 35 U.S.C. §103:**

In the Office Action at pages 6-10, the Examiner rejects claims 1, 3-6, 8-11, 13-16, 18 and 19 under 35 U.S.C. §103 in view of Kondoh et al. (U.S. Patent Publication No. 2001/56377) and Moore et al. (U.S. Patent No. 6,330,575). The rejection is respectfully traversed and reconsideration is requested.

On page 12 of the Office Action, the Examiner does not contend that the combination of Kondoh et al. and Moore et al. discloses the features as recited in claim 1, but instead asserts that Blinn et al. discloses any missing features. Since Blinn et al. is not used in the above noted rejection, and since the Examiner does not assert which portion of Kondoh et al. and Moore et al. or Kondoh et al., Moore et al., and Blinn et al. discloses each feature of the claimed invention, it is respectfully submitted that the Examiner has not provided sufficient evidence that the combination(s) disclose the features of the claimed invention as is required to maintain a prima facie obviousness rejection of claim 1. MPEP 2143.

Additionally, it is respectfully submitted that, consistent with the Examiner's statements on pages 10 and 12 of the Office Action for the reasons previously set forth in the Amendment of January 7, 2004, the combination of Kondoh et al. and Moore et al. does not disclose the invention recited in claim 1.

For at least similar reasons, it is respectfully submitted that the combination of Kondoh et al. and Moore et al. does not disclose or suggest the invention recited in claims 3, 8, 13, 15, and 19.

**CERTIFICATE OF FACSIMILE TRANSMISSION**

I hereby certify that this correspondence is being transmitted via facsimile to: Commissioner for Patents,  
P.O. Box 1450, Alexandria, VA 22313-1450  
on 17 Sept, 2004  
STAAS & HALSEY

**SERIAL NO. 09/764,220****DOCKET NO. 1293.1161**

Claims 4-6, 9-11, 14, 16, and 18 are deemed patentable due at least to their depending from corresponding claims 3, 8, 13, and 15.

In the Office Action at pages 10-11, the Examiner rejects claims 2, 7, and 12 under 35 U.S.C. §103 in view of the eSHOP Technology Merchant Manual, Blinn et al., or Kondoh et al. in view of Moore et al., and Dunworth et al. (U.S. Patent No. 5,930,474). The rejection is respectfully traversed and reconsideration is requested.

On page 12 of the Office Action, the Examiner argues that it would have been obvious to use the mapping system of Dunworth et al. in order to have the goods shipped home since it is more convenient to have the goods shipped at home instead of picking up the good, thereby cutting the traveling time to locate the exact address of the good.

As a point of clarification and as similarly noted in Amendment filed January 7, 2004, Dunworth et al. is drawn to a mapping system in which a web organizer server 114 provides users with a geographically organized perspective of available information. Using the server 114, the user can find a geographically convenient location for the appropriate good (i.e., a book), and is prevented from only locating the good in an undesirable location requiring the user to travel for hours to obtain the good. (Col. 7, lines 5-29 of Dunworth et al.) As such, the utility of the mapping information in Dunworth et al. is disclosed as being to reduce travel time where the user opts to pickup the good at the merchant. There is no suggestion as to why one of ordinary skill in the art would use the mapping information in the context of internet based purchases in which the merchant is to ship the purchased good, such as those disclosed in the eSHOP Technology Merchant Manual, Blinn et al., or Kondoh et al. in view of Moore et al.

Specifically, the user already realizes the advantage suggested by the Examiner in the eSHOP Technology Merchant Manual, Blinn et al., or Kondoh et al. in view of Moore et al. without using the mapping information of Dunworth et al. since each of these services discloses shipping the product instead of having the customer pickup the product. It is unclear from the record as to the benefit suggested in the prior art which would be conferred by using the

**SERIAL NO. 09/764,220****DOCKET NO. 1293.1161**

mapping information of Dunworth et al. instead of merely shipping the product regardless of location as suggested in the eSHOP Technology Merchant Manual, Blinn et al. or Kondoh et al. In view of Moore et al. Therefore, there remains insufficient evidence of record as to why one of ordinary skill in the art would use the mapping information of Dunworth et al., which is used to shorten travel time where a customer is to pickup a good, in the systems disclosed in the eSHOP Technology Merchant Manual, Blinn et al. or Kondoh et al. In view of Moore et al., which disclose shipping the good instead of requiring the user to pickup the good.

Further, the Examiner does not provide evidence that the motivation set forth on page 12 of the Office Action existed in the prior art.

In view of the above, it is respectfully submitted that there is insufficient evidence of record to maintain a prima facie obviousness rejection of claims 2, 7, and 12 in view of the eSHOP Technology Merchant Manual, Blinn et al. or Kondoh et al. In view of Moore et al., and Dunworth et al. under 35 U.S.C. §103.

In the Office Action at pages 11-12, the Examiner rejects claim 1 under 35 U.S.C. §103 in view of the eSHOP Technology Merchant Manual, Blinn et al. or Kondoh et al. in view of Moore et al., and Sharp et al. (U.S. Patent No. 6,263,317). The rejection is respectfully traversed and reconsideration is requested.

As a point of clarification, It is respectfully submitted that, consistent with the Office Action mailed October 7, 2003 and since the features set forth in the Office Action on page 11 are not recited in claim 1, the Examiner intended to reject claim 11 instead of claim 1 using the above combination. If this assumption is incorrect, it is respectfully submitted that, since Sharp et al. is not relied as curing the above noted deficiency of eSHOP Technology Merchant Manual, Blinn et al. or Kondoh et al. in view of Moore et al. as applied to claim 1, that the combination of eSHOP Technology Merchant Manual, Blinn et al. or Kondoh et al. in view of Moore et al. and Sharp et al. does not disclose or suggest the invention recited in claim 1.

If this assumption is correct, the Examiner does not rely upon Sharp et al. as curing the

**SERIAL NO. 09/764,220****DOCKET NO. 1293.1161**

above noted deficiency of eSHOP Technology Merchant Manual, Blinn et al. or Kondoh et al. in view of Moore et al. as applied to claim 8. As such, it is respectfully submitted that claim 11 is deemed patentable due at least to the combination not disclosing or suggesting the invention recited in claim 8, from which claim 11 depends.

**CONCLUSION:**

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot. And further, that all pending claims patentably distinguish over the prior art. Thus, there being no further outstanding objections or rejections, the application is submitted as being in condition for allowance which action is earnestly solicited.

If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited and possibly concluded by the Examiner contacting the undersigned attorney for a telephone interview to discuss any such remaining issues.

If there are any additional fees associated with the filing of this Response, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS &amp; HALSEY LLP

By: James G. McEwen  
Registration No. 41,983

1201 New York Avenue, NW, Suite 700  
Washington, D.C. 20005  
Telephone: (202) 434-1500  
Facsimile: (202) 434-1501

Date: SEPT. 17, 2004

**CERTIFICATE OF FACSIMILE TRANSMISSION**  
I hereby certify that this correspondence is being transmitted via facsimile to: Commissioner for Patents,  
P.O. Box 1450, Alexandria, VA 22313-1450  
on 17 SEPT 2004  
STAAS & HALSEY, LLP  
By: James G. McEwen  
Date: 17 SEPT 04  
Page 10 of 10